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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,892	06/28/2006	Peter Bleckert	P18823-US1	1926
27045	7590	11/13/2009		
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			EXAMINER HOQUE, NAFIZ E	
			ART UNIT	PAPER NUMBER
			2614	
			MAIL DATE	DELIVERY MODE
			11/13/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,892	Applicant(s) BLECKERT ET AL.	
	Examiner NAFIZ E. HOQUE	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 19, 21-24, 26-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 19, 21-24, 26-29 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicants' claims filed on September 01, 2009 have been entered. No claims have been amended. No claims have been added or cancelled. Claims 18-19, 21-24, 26-29, and 31-34 are still pending in this application, with claims 18, 23, and 28 being independent.

Response to Arguments

2. Applicant's arguments with respect to claim 18-19, 21-24, 26-29, and 31-34 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argued that previous references does not "discloses or suggests a method/apparatus for two communication systems (a CS network and a PS network) to automatically discover whether a packet data channel can be established between a caller and a called party by the two communication systems for transfer of real time media, such as video, or non-real time media, such as images, in parallel with the voice call".

Sylvain (US 7,366,183) discloses two communication systems (fig 1 - a CS network 12 and a PS network 26) automatically discover whether a packet data channel can be established between a caller and a called party (see abstract and rejection below) by the two communication systems for transfer of media in parallel with the voice call (col. 9, lines 31-35).

Art Unit: 2614

Remarks

3. Claims 23-24, 28, 32 recite “adapted to” and thus the claims’ scope is not limited by claimed language that suggests or makes optional but does not require steps to be performed. Further, such limitations may not be given weight in future office actions.

Please see MPEP 2111.04

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 18-19, 21-24, 26-29, and 31-34 rejected under 35 U.S.C. 102(e) as being anticipated by Sylvain (US 7,366,183).

Regarding claims 18, 21, 23, 26 and 28-29, Sylvain discloses a method for automatically discovering a shared multimedia service capability of two user equipments when initiating a voice call between two parties, one of the user's equipment, which belongs to a calling party being capable of running simultaneously both a circuit switched voice call in a CS network, and a packet switched IP session supported by a PS network, and at least one second user equipment, belonging to a called party, which multimedia capability may be unknown to the calling party and for discovering matching

Art Unit: 2614

multimedia capability of the two user equipments when initiating a voice call over the circuit switched network to the other user equipment (col. 1, line 50 - col. 2, line 12; col. 4, lines 15-39; col. 3, lines 49-59), the method comprising the steps of:

receiving from means in the CS network simultaneously a capability request for the two user equipments to the PS network supporting the SMM service (col. 2, line 57 – col. 3, line 2);

analyzing the capability request by means in the PS network (col. 4, lines 52-67); and responding simultaneously to the user equipments information regarding matching multimedia capability (col. 3, lines 11-15), if at least one matching service is found, wherein the receiving, analyzing and responding steps are performed by a SIP Application Server for Shared Multimedia Services (col. 5, lines 25-30 – SIP Server).

Regarding claims 19 and 24, Sylvain discloses the step of registering the supported SMM Capabilities of the user equipment SMM Capabilities in a SIP registration procedure towards an IMS element of the user equipment's home PS network at user equipment power on (col. 4, lines 55-67; col. 5, lines 6-22).

Regarding claims 22, 27, and 31, Sylvain discloses wherein the generation of capability requests by the means in the CS network is based on IN technology or Parlay technology (fig. 1, element 18; col. 3, lines 34-36 – SS7 signaling therefore IN technology).

Regarding claims 32-34, Sylvain discloses a computer program product comprising computer executable software stored on a computer readable medium, the

Art Unit: 2614

software being adapted to run on a computer or other processing means (see fig. 6, el. 42; also see fig 7).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAFIZ E. HOQUE whose telephone number is (571)270-1811. The examiner can normally be reached on M-F Alternate Fridays Off 7:30 - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harry S. Hong/
Primary Examiner, Art Unit 2614

/NAFIZ E HOQUE/
Examiner, Art Unit 2614